



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/822,438	03/21/1997	MICHELE BOVIO	PD25-661(DEC	6352

7590 04/08/2004

MICHAEL G. FLETCHER
FLETCHER, YODER & VAN SOMEREN
P.O. BOX 692289
HOUSTON, TX 77269-2289

EXAMINER

PATEL, ASHOK

ART UNIT	PAPER NUMBER
----------	--------------

2879

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

08/822,438

Applicant(s)

BOVIO ET AL.

Examiner

Ashok Patel

Art Unit

2879

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2000 and 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date g.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 2879

1. Applicant's election of claims 1-8 in Paper No. 12 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Upon re-consideration, the Examiner restricts originally submitted claims into four groups I-IV as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, drawn to a mounting system, classified in class 248, subclass 205.1.

II. Claims 9-13, drawn to a folding top, classified in class 361, subclass 681.

III. Claims 14-16, drawn to a flat panel display, classified in class 313, subclass 422.

IV. Claims 17-20, drawn to a method, classified in class 445, subclass 22.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are divergent.

Art Unit: 2879

Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the flay panel device does not require mounting device of claim 1 or the mounting members of claim 2. The sub-combination has a separate utility such as a clamp, a frame etc..

4. Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the flat panel display of claim 14 does not require the plastic back, recited in claim 9, behind the metal bracket and extending around the flat panel display. As to claim 15, the flat panel display does not require pivot coupling or metal bracket or

Art Unit: 2879

plastic back as recited in claim 9. The subcombination has separate utility such as a folding tray.

Inventions IV and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, it is not required to insert the mounting members laterally to engage fixtures (the term lateral is a relative term). Also the claimed product does not require providing fixtures in the sidewalls of the display.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III or IV, restriction for examination purposes as indicated is proper.

Art Unit: 2879

7. The Examiner realizes that the claims 1-20 should have been restricted originally in terms of either *different groups* or *combination of groups and species* instead of *only species*.

Regardless, however in view of applicant's election of claims 1-8 *without* traverse, claims 9-20 are withdrawn from consideration. An action on merits including claims 1-8 appears below.

8. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 1 and 2, these claims include single means.
See M.P.E.P. 2164.08(a).

Dependent claims 3-8 are necessarily rejected since they depend upon base claim 2.

Art Unit: 2879

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohgami et al (USPN 5,905,550).

Ohgami et al disclose applicant's claimed mounting system (Figures 1, 2, 6) including means (11a, 11b or 17a, 17b, 17c) of a flat panel display, as claimed by applicant.

As to claim 1, the Examiner does not give a patentable weight to the limitation "that are adapted to mount it in the top cover" (lines 4-5) since it is narrative and does not constitute a positive structure and/or does not perform a specified function.

As to claim 2, Ohgami et al disclose applicant's claimed mounting structure including lateral mounting members (top, bottom and two side members, adjacent display screen periphery)

Art Unit: 2879

extending from a top cover to engage side walls of a flat panel display.

12. Claims 1-4 and 8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ma (USPN 5,570,267).

Ma discloses applicant's claimed mounting system (Figures 1-3) including means (2, 11) of a flat panel display, as claimed by applicant.

As to claim 1, the Examiner again does not give a patentable weight to the limitation "that are adapted to mount it in the top cover" (lines 4-5) for reasons set forth earlier in this office action.

As to claim 2, Ohgami et al disclose applicant's claimed mounting structure including lateral mounting members (11 and/or an element shown between elements 1 and 3) extending from a top cover to engage side walls of a flat panel display.

The Examiner notes that applicants have claimed the mounting system for intended use in the flat panel display, which display includes different several elements, such as: folding top cover (claims 2, 3, 5, 7), sides walls (claims 2), a side wall of the top cover (claim 3), plastic back, pivotal couplings and base unit (claim 5), bosses (claims 4, 6 and 8), a display panel, display rim display back (claim 8) etc..

Art Unit: 2879

However, since claims are directed to the mounting structure and not to the flat panel display, the Examiner does not give a patentable weight to any element (mentioned in the last paragraph) that does not constitute a positive structure of the claimed mounting system. The Examiner does give a patentable weight to any element (mentioned in the last paragraph) that is structurally related to the claimed mounting system.

In order for the element to be given a patentable weight, the element has to be recited within the claim with a sufficient positive structural limitation.

As to claim 3, Ma discloses the mounting members (2 or 11) extend through a side wall of the top cover.

As to claim 4, mounting members includes bolts to engage bosses in the flat-panel display.

As to claim 8, as shown in the Figure 3, the flat panel display includes a display panel and display (12, 2) extending around a perimeter of the display (12), and a display back (3 and/or 4), the lateral mounting members includes bolts, that engage bosses in the display back of the flat panel display, behind the rim.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Art Unit: 2879

Nelson, Podwalny et al and Tao each are cited for showing a general structure of a mounting structure in a flat panel display device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok Patel whose telephone number is 571-272-2456. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel can be reached on 571-272-2457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.


Ashok Patel
Primary Examiner
Art Unit 2879